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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/638,845	08/11/2003	Lan Zhiyin	409251	4451

30955 7590 05/31/2006

LATHROP & GAGE LC
4845 PEARL EAST CIRCLE
SUITE 300
BOULDER, CO 80301

EXAMINER

PRICE, ELVIS O

ART UNIT	PAPER NUMBER
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1621

DATE MAILED: 05/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/638,845

Applicant(s)

ZHIYIN ET AL

Examiner

Elvis O. Price

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/26/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claims 1-22 are pending in the application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 18-20 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Cheng et al. (Chinese Pat. 1225356; abstract only).

Cheng et al. disclose a process for preparing a compound according to the present formula II by condensing 4-methoxyphenylacetonitrile with cyclohexanone in the presence of (sodium hydride) NaH and a solvent. The condensed product is then reduced using a metal hydride in a solvent (see abstract).

Claims 6-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Shepard. (US Pat. 5,043,466).

Shepard discloses a process for preparing a compound according to the present formula II by reacting a nitrile according to the present formula I with diisopropylamino lithium solution in a solvent (see Example 1).

Claims 12-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Husbands et al. (US Pat. 4,535,186).

Husbands et al. disclose a process for preparing a compound according to the present formula III by reducing, in a solvent, a compound according to the present formula II by catalytic hydrogenation (see Example 2)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 5, 6, 10, 11, 12, 17, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheng et al. or Shepard or Husbands et al. in view of Jerussi et al. (US Pat. 6,342,533 B1).

Applicant claims a process for preparing compounds of formulas II and/or III by reacting nitriles or amides of the formula I with cyclohexanone in the presence of a solvent and a base followed by reducing certain condensed products with reducing agents in the presence of a solvent.

The Cheng et al. and/or Shepard and/or Husbands et al. references (as recited above) teach a process for preparing compounds according to the present formulas II and/or III. However, none of the references alone teach the particulars as define by the present claim 5, 10, 11, 17 and 21.

However, Jerussi et al. teaches methods for preparing compounds according to the present formulas II and/or III by condensing nitriles or amides with cyclohexanone in the presence of a solvent and a base followed by the reduction of the condensed products with reducing agents in the presence of a solvent. Jerussi et al. also expressly teach that the base, solvents, and reducing agents are not limited to those that are specifically disclosed and that bases, solvents, and reducing agents known to those skilled in the art can also be used (See Col. 11).


It would have been *prima facie* obvious to one having ordinary skill in the art, in view of the references cited above, to arrive at the presently claimed invention because each reference teaches the same material process for preparing compounds of the present formulas II and/or III and Jerussi et al. also suggest that other condensation bases, solvents, and reducing agents can be using by those skilled in the art to carry out the processes of preparing compounds of the present formulas II and/or III.

One having ordinary skill in the art, desiring to arrive at optimum alternative methods for preparing compounds of the present formulas II and/or III, would have been motivated to vary the condensation bases, solvents and reducing agents. Therefore the presently claimed invention would have been obvious to one having ordinary skill in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elvis O. Price whose telephone number is 571 272-0644. The examiner can normally be reached on 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on 571 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Elvis O. Price